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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,421	12/08/2000	Robert E. Haines	10003228-1	2077

7590 11/21/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BRASE, SANDRA L

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,421

Applicant(s)

HAINES, ROBERT E.

Examiner

Sandra L. Brase

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-30, 38-43 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-30, 38-43 and 50-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawal of Final

The final rejection mailed 09/24/03 is withdrawn, since it was determined to be premature. This is in agreement with the argument by Applicant's representative, Robert Hyta, in a telephone conversation 11/20/03. The action on the merits of the pending claims follows.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 24-29, 38-42, 51, 52 and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohtani (US 6,108,099).

3. Ohtani (...099) discloses a method of scheduling a hard copy output engine comprising: providing a hard copy output engine (20) configured to use a consumable commodity comprising: a sensor (col. 4, lines 28-33); a processor (1); a memory (3); sensing status information of the consumable commodity (col. 4, lines 28-33); processing the status information, wherein the processing includes comparing the status information to information housed in the memory to determine if notification should occur to a notification recipient (col. 4, lines 62-65); composing an electronic message to the notification recipient that includes the detected status information (abstract; col. 4, line 66 – col. 5, line 1; col. 5, line 53 – col. 6, line 7;

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and col. 7, lines 1-15); and transmitting the electronic message from the hard copy output engine to a scheduling engine (col. 6, lines 34-36; and col. 7, lines 44-47). A computer implemented hard copy output engine control system, the system comprising: a plurality of sensors coupled to the hard copy output engine, the sensors being configured to provide status information relating to a plurality of aspects of the hard copy output engine (col. 4, lines 28-33); and processing circuitry (1) coupled to the sensors, the processing circuitry configured to: read the sensors and detect the status of the aspects of the hard copy engine (col. 4, lines 62-65); and selectively look up from a memory contact information for a notification recipient intended to be notified of the status of the aspects of the hard copy engine, compose an electronic message including the detected status (abstract; col. 4, line 66 – col. 5, line 1; col. 5, line 53 – col. 6, line 7; and col. 7, line 1-15), and transmit the electronic message from the hard copy output engine to a scheduling engine (col. 6, lines 34-36; and col. 7, lines 44-47). The detecting status includes a toner out status (abstract; and col. 4, lines 28-29). The sensor and the processor are configured to sense and process information relating to paper inventory (col. 4, lines 62-65), out of paper (col. 4, lines 31-33) and out of consumables (col. 4, lines 28-33). Composing an electronic message includes composing the electronic message to include information including: date sent (col. 6, lines 10-11 and col. 7, line 19), addressee (col. 6, lines 12-13 and col. 7, lines 20-21), consumable order list (col. 6, lines 27-33; and col. 7, lines 37-43) and malfunction (col. 6, lines 60-63). The detecting status and aspects of the hard copy output engine includes: toner out (abstract; and col. 4, lines 28-33); out of paper (abstract; and col. 4, lines 28-33); and out of consumables (abstract; and col. 4, lines 28-33). The hard copy output engine can be a facsimile machine, photocopier and printer (col. 1, lines 6-11). The scheduling engine comprises

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transmitting an electronic message including a consumable order (col. 6, lines 27-33; and col. 7, lines 37-43).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30, 43, 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani (US 6,108,099) and Tarr et al. (US 5,184,179).

6. Ohtani (...099) discloses the features mentioned previously, but does not disclose sensing a future need for preventive maintenance, replacement of a component part and maintenance. Tarr et al. (...179) disclose a hard copy output apparatus and method including sensing a future need for preventive maintenance (col. 6, lines 20-23); replacement of a component part (col. 7, line 61 – col. 8, line 55); and information relating to maintenance (col. 6, line 20-23; and col. 7, line 61 – col. 8, line 55). It would have been obvious to one of ordinary skill in the art at the time of the invention to sense a future need for preventive maintenance, replacement of a component part and maintenance, as disclosed by Tarr et al. (...179), so that maintenance can be properly and timely performed on the copy output engine.

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Response to Arguments

7. Applicant's arguments with respect to claims 24-30, 38-43 and 50-56 have been considered but are moot in view of the new ground(s) of rejection.
8. Applicant's arguments filed 7/1/03 have been fully considered but they are not persuasive.
9. Applicant argues that Ohtani (US 6,108,099) does not teach or suggest a hard copy device that senses, processes and transmits electronic messages; however, this is incorrect, as explained in the rejection above. Moreover, applicant argues that none of the cited references teach the limitations a claimed in claims 24, 38 and 51; however, this is incorrect, as explained above, Ohtani (...099) discloses the limitations of claims 24, 38 and 51.

Contacts \ Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra L. Brase whose telephone number is (703) 308-3101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 or 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Sandra L. Brase
Primary Examiner
Art Unit 2852

November 20, 2003